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| 20995 7590 04/30/2010 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/618,957

Applicant(s)

YAMAMOTO ET AL.

Examiner

VICTOR S. CHANG

Art Unit

1783

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2010.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8, 10-17 and 19-22 is/are pending in the application.
4a) Of the above claim(s) 13, 16 and 17 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 8, 10-12, 14, 15 and 19-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date 2/19/10
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ ~~Notes of Informal Patent Application~~
6) ☐ Other: _____

DETAILED ACTION

Introduction

1. Applicants' arguments and amendments filed 4/5/2010 have been entered. The specification and claims 8 and 14 have been amended. New claims 21 and 22 have been entered. Claims 8, 10-12, 14, 15 and 19-22 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 8 and 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, in independent claim 8, the newly added exclusionary limitation "wherein said transparent surface protective film does not contain a light absorbing compound" is new

matter. It is noted that at Remarks page 5 applicants point to specification page 10, second paragraph, as support for the limitation. However, nowhere is there a disclosure in the original specification page 10 filed 7/14/2003 mentioning a light absorbing compound, or the lack of it in the film. Additionally, since inherently the phrase “does not contain a light absorbing compound” is equivalent to “free of light absorbing compound”, it is new matter under the rule of *Ex Parte Grasselli et al.* – Bd. of App. 231 PQ 393, Affd. 738 F. 2d 453 (Fed. Cir. 1984) to the effect that a limitation such as “free of” a particular element is new matter in the absence of express support of the concept of exclusion.

Claim Rejections - 35 USC § 103

6. Claims 8, 10-12, 14, 15, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumi (US 6582789) in view of Masuda (US 20020064650A1).

Sumi's invention relates to a protective film for liquid crystal display. See Abstract. The film is treated by an antistatic agent on the surface of the surface protective film opposite to the surface in which the adhesive layer is formed. See Abstract. Useful films include biaxially oriented polyethylene terephthalate (PET) film. See col. 3, ll. 6 and 18. The thickness of the adhesive layer is preferably 3 to 50 micrometers. See col. 5, ll. 60. Examples of adhesives include acrylic adhesive having 2-ethylhexyl acrylate as a main monomer, vinyl acetate as a comonomer and hydroxyethyl methacrylate as a functional group-containing monomer in a ratio of 7:2:1. See col. 15, ll. 60-63.

For claims 8, 10-12, 14, 15 and 19-22, Sumi lacks a teaching to form the antistatic layer of polymers having pyrrolidinium rings as multiple repeating units in main chains. However,

Masuda's invention relates to a polyester film for window application. See Abstract. The film comprises at least one side thereof an antistatic coating. The antistatic coating has a specific surface resistance of not more than $1.0 \times 10^{13} \Omega$, and a haze of not more than 5.0% and a visible light transmittance of 3 to 70% (transparent). See [0012]. Examples of the antistatic agents include polymers having a backbone containing repeating units of pyrrolidinium rings. See [0031]. Examples of useful polyesters include polyethylene terephthalate (PET), etc. See [0017]. On the side opposite from the antistatic coating of the polyester film, an adhesive is applied for pasting the film on window glass. See [0044]. It would have been an obvious modification to one of ordinary skill in the art to modify the antistatic layer of Sumi with polymers having pyrrolidinium rings as multiple repeating units in main chains, as taught by Masuda, because the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. Regarding the use limitations in the preamble, since statements of intended use do not serve to distinguish structure over the prior art, it has not been given any patentable weight. *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). Regarding the functional limitation "being configured to maintain transparency even after one-hour heat treatment at 150°C", absent any evidence to the contrary, it is deemed to be inherent to the same structure and composition of the film as the claimed invention, which is rendered obvious by the collective teachings of prior art as set forth above. Regarding newly added limitation "wherein said transparent surface protective film does not contain a light absorbing compound" in claim 8, nowhere has Sumi taught that the protective film necessarily requires a light absorbing compound. Regarding new added limitation "wherein the entirety of the surface protective film is transparent upon visual inspection" in claim 14,

absent a standard for the term “visual inspection”, any visually transparent meets the limitation. Since Sumi’s protective film is used for liquid crystal display, it is necessarily transparent for a display viewer.

7. Claims 8, 10-12, 14, 15 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-256116 [computer English translation] in view of Masuda [US 20020064650A1].

JP ‘116 relates to a transparent surface-protective film for various displays. See [0002]. The film comprises a highly transparent polyethylene terephthalate (PET) film, which is preferably biaxially oriented. An antistatic layer is provided on one side of the PET film, and an adhesive layer is provided on the opposite side. See [abstract]. The thickness of the adhesive layer is 3-100 micrometers. See [0040]. Useful adhesives include acrylic pressure sensitive adhesive. See [0035].

For claims 8, 10-12, 14, 15 and 20, JP ‘116 lacks a teaching to form the antistatic layer of polymers having pyrrolidinium rings as multiple repeating units in main chains. However, Masuda’s invention relates to a polyester film for window application [abstract]. The film comprises at least one side thereof an antistatic coating. The antistatic coating has a specific surface resistance of not more than $1.0 \times 10^{13} \Omega$, and a haze of not more than 5.0% and a visible light transmittance of 3 to 70% (transparent). See [0012]. Examples of the antistatic agents include polymers having a backbone containing repeating units of pyrrolidinium rings. See [0031]. Examples of useful polyesters include polyethylene terephthalate (PET), etc. See [0017]. On the side opposite from the antistatic coating of the polyester film, an adhesive is applied for pasting the film on window glass. See [0044]. It would have been an obvious modification to

one of ordinary skill in the art to modify the antistatic layer of JP '116 with polymers having pyrrolidinium rings as multiple repeating units in main chains, as taught by Masuda, because the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. Regarding the use limitations in the preamble, since statements of intended use do not serve to distinguish structure over the prior art, it has not been given any patentable weight. *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). Regarding the functional limitation "being configured to maintain transparency even after one-hour heat treatment at 150°C", absent any evidence to the contrary, it is deemed to be inherent to the same structure and composition of the film as the claimed invention, which is rendered obvious by the collective teachings of prior art as set forth above. Regarding newly added limitation "wherein said transparent surface protective film does not contain a light absorbing compound" in claim 8, nowhere has JP '116 taught that the protective film necessarily requires a light absorbing compound. Regarding new added limitation "wherein the entirety of the surface protective film is transparent upon visual inspection" in claim 14, absent a standard for the term "visual inspection", any visually transparent meets the limitation. Since JP '116 relates to a highly transparent film, it is inherently transparent for a viewer.

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-256116 [computer English translation] in view of Masuda [US 20020064650A1] and Sumi [US 6582789].

The teachings of prior art are again relied upon as set forth above.

For claim 19, the prior art is silent about the amount of co-monomer in the acrylic adhesive. However, Sumi's invention relates to a protective film, and exemplifies a useful

acrylic adhesive comprising 2-ethylhexyl acrylate as a main monomer, vinyl acetate as a comonomer and hydroxyethyl methacrylate as a functional group-containing monomer in a ratio of 7:2:1. See col. 15, ll. 60-63. It would have been obvious to one of ordinary skill in the art to select a known acrylic adhesive composition of Sumi to make the protective film of JP '116, because the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

Response to Arguments

9. Applicants argue at Remarks page 6:

“Sumi and Masuda teach away from their combination because Sumi teaches the importance of a surface protective film being highly transparent, and Masuda teaches the criticality of incorporating a dye into the film.”

However, nowhere Masuda teaches that the dye in the film substrate is result effective for the function of the antistatic layer. Applicants' argument directed to features of Masuda not relied upon is misplaced and unpersuasive.

Similarly, applicants' arguments at Remarks pages 7-10 relating to features of Masuda not relied upon for the grounds of rejections are misplaced.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 6:00 am - 4:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Victor S Chang/
Primary Examiner, Art Unit 1783